

REMARKS

Claims 1-4 and 6-22 remain pending herein.

Claim 5 is cancelled hereby. New claims 23-33 are added hereby.

Thus, claims 1-4 and 6-33 are pending herein.

Attached hereto as pages 15-17, pursuant to Rule 1.121(c)(1)(ii), is a marked-up version of the amended claims.

In response to the statement in the Office Action that the status of the related application must be provided, the specification is amended herein to update the status of the parent application, including listing the U.S. Patent Number.

In addition, it is respectfully requested that the U.S. PTO acknowledge the claim for domestic priority under 35 U.S.C. §120 based on parent application U.S. Serial No. 09/335,714, filed June 18, 1999, by checking box 15 in the Office Action Summary, page 1 of the Office Action.

The Office Action contains a statement that the PTO Form 1449 filed August 22, 2001 is not present in the PTO file for the present application. Attached is an additional copy of that PTO Form 1449. Also attached is a copy of a Postcard received bearing the U.S. PTO date stamp, acknowledging that the PTO Form 1449 was filed in the PTO on August 22, 2001. Acknowledgment that the references listed on the Form 1449 have been considered in this application is respectfully requested.

Claims 6, 9 and 15-22 were rejected under 35 U.S.C. §112, second paragraph.

The Office Action objects to the expression "handle facilitating gripping" in claim 6. Claim 6 has been amended as set forth above to eliminate the quoted expression.

In addition, the word "like" in claims 9 and 18 was objected to. Claims 9 and 18 have been amended as set forth above to eliminate the word "like".

In addition, claim 15 has been amended as set forth above to address the concerns set forth in the Office Action.

Reconsideration and withdrawal of this rejection are requested.

Near the top of page 3, the November 14, 2002 Office Action contains a statement to the effect that the present application was not filed after November 29, 2000, and that the present application is being examined under 35 U.S.C. §102(e) prior to AIPA. It is respectfully noted that the present application was filed on August 22, 2001, and therefore the AIPA amendments *do* apply to the present application. It is further noted that the present

application has been published. Appropriate correction by the U.S. PTO is respectfully requested.

Claims 1-3, 5 and 6 were rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 836,217 (Rowe '217).

Claim 1 is amended as set forth above to provide claim coverage which is more clearly distinct from the granted claim coverage in the parent of the present application. Accordingly, claim 1 has been amended as set forth above to recite an electric vibrator coupled to the opposite ends of the fingers, whereby vibrations generated by the electric vibrator are transmitted from the opposite ends through the fingers to the free ends of the fingers.

Rowe '217 very clearly does not disclose or suggest an electric vibrator. The structure identified with the reference number 4 in Rowe '217 is a cross-bar (see Rowe '217, column 1, lines 33-36, 42 and 47). The fingers 9 of Rowe '217 extend through holes 8 formed in the cross-bar 4. A rod 5 is fixed to the cross-bar 4 at one end and attached to the head of the forceps via a ring 6 and a pin 7. Based on the disclosure in Rowe '217, it would appear that in using the forceps of Rowe '217, a surgeon would place one of his or her hands through the loop in the handle 11 and would grip the cross-bar 4 with his or her fingers. In order to open the forceps, the surgeon would then pull the cross-bar 4 toward the handle 11, having the effect of pulling the head of the forceps between the fingers 12, thereby spreading the free curved ends 10 of the fingers 9. There is clearly no basis in Rowe '217 for any suggestion that the cross-bar 4 is a vibrator as recited in claim 1. Accordingly, reconsideration and withdrawal of this rejection are requested.

Claims 7-11 were rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,018,511 (Yokoi '511).

Claim 7 recites a specific configuration of fingers, such fingers being coupled with a vibrator. Yokoi '511 fails to disclose or suggest the claimed configuration of fingers.

Yokoi '511 discloses a portable massaging device which is typically strapped to a chair and is provided with a number of plates 10, 10A, and 10B which are provided with protrusions 11 and/or flexible leaves 13 with protrusions 11, for massaging various body parts. The plates 10, 10A and 10B are mounted on a base plate 20 via a support plate 21, and are vibrated by a combination of a motor 22 and a vibrator 26. The PTO appears to have taken the position that the leaves 13 of Yokoi '511 are analogous to the fingers recited in

claim 7. However, claim 7 further recites that the fingers define *a self-supporting head receiving space for receiving a head, the space extending between the free ends of the fingers and the opposite ends of the fingers and having a self-maintained opening at one end formed by a juxtaposition of the free ends of the fingers, the opening being of a circumference smaller than a circumference of the head.* This feature is clearly not disclosed or suggested in Yokoi '511, which clearly discloses that such features are *not* present in the massager unit disclosed in Yokoi '511.

Accordingly, the subject matter of claims 7-11 is not anticipated by Yokoi '511, nor would it have been obvious in view of Yokoi '511. Accordingly, reconsideration and withdrawal of this rejection are requested.

Claims 1-10, 13-19 and 22 were rejected under 35 U.S.C. §102(e) over U.S. Patent No. 6,251,089 (Kuznets '089).

The PTO apparently takes the position that the motor 56 of Kuznets is a vibrator. However, as discussed below, the motor 56 of Kuznets '089 is clearly *not* a vibrator. The motor 56 rotates a shaft 53 which in turn rotates a shaft 54 for *rotating* a massage head 64. Rotation is not the same as, nor does it encompass, vibration. A position that a motor providing rotary output anticipates a vibrator would be untenable. The reason that Kuznets '089 does not disclose a vibrator and does not disclose vibrating motion follows from the purpose to which Kuznets '089 is directed, as disclosed in the background of the invention section of Kuznets '089. In particular, Kuznets '089 discloses that the invention disclosed therein is directed to providing a device which provides a massaging effect by *stroking, rubbing and kneading* (Kuznets '089, column 1, lines 5-28; column 2, lines 27-32).

Accordingly, Kuznets '089 fails to anticipate any of the subject matter recited in claims 1-10, 13-19 and 22. Accordingly, reconsideration and withdrawal of this rejection are requested.

Claims 11, 12, 20 and 21 were rejected under 35 U.S.C. §103(a) over Kuznets '089.

The only statement relating to this rejection is an allegation by the PTO that copper is a well known material. Accordingly, such a statement does not address or eliminate the clear distinctions between independent claims 7 and 15 (from which each of claim 11, 12, 20 and 21 ultimately depend) relative to the subject matter disclosed in Kuznets '089. Accordingly, reconsideration and withdrawal of this rejection are requested.

Claims 1-4 were rejected under obviousness-type double patenting over claims 1-26 of U.S. Patent No. 6,309,365 (Lacey '365).

As discussed above, claim 1 has been amended to recite an electric vibrator coupled to the opposite ends of the fingers. As acknowledged in paragraph 11 of the November 14, 2002 Office Action, claims 1-26 of Lacey '365 do not recite a vibrator. In addition, claims 1-26 of Lacey '365 do not contain any suggestion of any vibrator. Accordingly, reconsideration and withdrawal of this rejection are requested.

Claims 5-22 were rejected under obviousness-type double patenting over claims 1-26 of Lacey '365 in view of U.S. Patent No. 5,511,270 (Eliachar '270).

Along with acknowledging that claims 1-26 of Lacey '365 do not recite a vibrator, the PTO asserts that Eliachar '270 discloses a vibrator. The PTO asserts that merely in view of the alleged disclosure of a vibrator in Eliachar '270, it would have been obvious to modify claims 1-26 of Lacey '365 so as to include a vibrator. The PTO presents no reasons why it deems that it would have been obvious to modify claims 1-26 of Lacey '365 by incorporating structure from Eliachar '270, where neither claims 1-26 of Lacey '365 nor Eliachar '270 contain any disclosure which would motivate one of skill in the art to attempt to make such a modification. In order to establish *prima facie* obviousness, the PTO must present evidence in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the prior art would have been led to combine the relevant teachings of the prior art in such a way as to arrive at the claimed invention. The PTO has presented no such evidence. Accordingly, reconsideration and withdrawal of this rejection are requested.

Favorable consideration of new claims 23-33 is respectfully requested. New claims 23-33 each recite that the fingers are non-rotating in order to further distinguish the claimed invention from Kuznets '089. In addition, claims 26 and 30 include further recitation that the opposite ends of the fingers are fixed relative to the vibrator, thereby even further distancing the claimed subject matter from Kuznets '089. Apart from this, new claim 23 incorporates the subject matter of original claims 1 and 5; claim 24 incorporates the subject matter of original claim 6; claim 25 incorporates the subject matter of original claim 2; and claims 26-33 incorporate the subject matter of original claims 7, 8, 9, 14, 15, 16, 17 and 18, respectively.

If the Examiner believes that contact with Applicant's attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicant's attorney at the phone number noted below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-1446.

Respectfully submitted,

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Date



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